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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,759	08/30/2000	Katsuhito Kanbe	001072	2550

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EXAMINER

HO, TUAN V

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,759

Applicant(s)

KANBE ET AL.

Examiner

TUAN HO

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 8, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 7, 9, 12-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>5</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2 and 3</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 2612

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to an expansion unit , classified in class 348, subclass 207.1.

II. Claims 15-17, drawn to an imaging device classified in class 348, subclass 375.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group I has separate utility such as an expansion unit can be used in any personal computer. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for

Art Unit: 2612

Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. Adrian on 5/14/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-17 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2612

8. Claims 1, 4-6, 8, 10 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 49, 50, 52, 54, 55, 56, 57, 59 and 61 of U.S. Patent No. 6,525,932. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

With regard to claim 1, claim 49, 50, 52 and 54 of the patent'932 disclosed the expansion unit (an expansion unit comprising a housing), imaging device (image-input device), moving member (a detachment mechanism moves the image-input device in and out of the housing; therefore, the mechanism would have been obvious over claimed moving member), member (angular adjustment mechanism would have been obvious over the member), and imaging device being detachable (image-input device is supportable by a cable when detachable from the expansion unit).

With regard to claim 4, claims 49, 50, 52 and 54 of the patent'932 disclosed the cable (a cable connects the image input device to the housing), and cable storage compartment (a storage compartment is inherently included in the housing of the expansion unit since when the image input device is inserted in the housing, there must be a space or compartment to hold the cable).

Art Unit: 2612

With regard to claim 5, claims 49, 50, 52 and 54 of the patent'932 disclosed the cable storage compartment (a storage compartment is inherently included in the housing of the expansion unit since when the image input device is inserted in the housing, there must be a space or compartment to hold the cable).

With regard to claim 6, claims 49, 50, 52 and 54 of the patent'932 disclosed the cable (a cable connects the image input device to the housing).

With regard to claim 8, claims 49, 50, 52 and 54 of the patent'932 disclosed the cable (a cable connects the image input device to the housing; where the cable must be in a wrapped state since the length of the cable is put into a narrow space inside the expansion unit).

With regard to claim 10, claims 49, 50, 52 and 54 of the patent'932 disclosed the mechanism (the detachment mechanism inherently includes features so as to properly detach or attach the image input device; otherwise, the image input would not proper function as an electronic camera).

With regard to claim 11, claim 49, 50, 52 and 54 of the patent'932 disclosed the portable information processing apparatus (an expansion unit would have been obvious over claimed portable information processing apparatus since the

Art Unit: 2612

expansion unit is portable and connected to an information processing apparatus), imaging device (image-input device), moving member (a detachment mechanism moves the image-input device in and out of the housing), member (angular adjustment mechanism), and imaging device being detachable (image-input device is supportable by a cable when detachable from the expansion unit).

With regard to claim 1, claim 56, 57, 59 and 61 of the patent '932 disclosed the expansion unit (an expansion unit), moving member (a detachment mechanism moves the image-input device in and out of the housing; therefore, it would have been obvious over claimed moving member), and member (angular adjustment mechanism would have been obvious over claimed member), except for the claimed imaging device.

However, claim 56 of the US patent recites "a position detecting information receiver provide in said housing", it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the position detecting information receiver with claimed image device because the image device also detects and receives position of an object information.

It is noted that the imaging device being detachable from the expansion unit and supportable in such detached state (a

Art Unit: 2612

cable in claim is used to support the imaging device even when it is detached).

With regard to claim 4, claims 56, 57, 59 and 61 of the patent'932 disclosed the cable (a cable connects the image input device to the housing), and cable storage compartment (a storage compartment is inherently included in the housing of the expansion unit since when the image input device is inserted in the housing, there must be a space or compartment to hold the cable).

With regard to claim 5, claims 56, 57, 59 and 61 of the patent'932 disclosed the cable storage compartment (a storage compartment is inherently included in the housing of the expansion unit since when the image input device is inserted in the housing, there must be a space or compartment to hold the cable).

With regard to claim 6, claims 56, 57, 59 and 61 of the patent'932 disclosed the cable (a cable connects the image input device to the housing).

With regard to claim 8, claims 56, 57, 59 and 61 of the patent'932 disclosed the cable (a cable connects the image input device to the housing; where the cable must be in a wrapped state since the length of the cable is put into a narrow space inside the expansion unit).

Art Unit: 2612

With regard to claim 10, claims 56, 57, 59 and 61 of the patent '932 disclosed the mechanism (the detachment mechanism inherently includes features so as to properly detach or attach the image input device; otherwise, the image input would not proper function as an electronic camera).

9. Claims 2, 3, 7, 9 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawamura et al discloses an electronic camera that can be inserted in a slot of a personal computer.

Ohmori discloses an electronic camera that an detachable display device.

Saito et al discloses an electronic camera that has a control module capable of connecting to the camera.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (703) 305-4943. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WENDY GARBER, can be

Art Unit: 2612

reached on (703) 305-4924. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

A handwritten signature in black ink, appearing to read 'Tuan Ho', with a stylized flourish at the end.

TUAN HO

Primary Examiner

Art Unit 2612